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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,199	04/05/2001	Bernard R. McKibben	IR105354	5384
22917	7590	11/10/2004	EXAMINER	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			POPHAM, JEFFREY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/827,199	Applicant(s) MCKIBBEN ET AL.	
	Examiner Jeffrey D. Popham	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input checked="" type="checkbox"/> Other: <u>1472</u> . |

Remarks

Claims 1-19 are pending.

Drawings

1. The drawings are objected to because Page 11, lines 5-7 state that the LEA provides an IPSec negotiation response 210, but the arrow in Fig. 2 is going towards the LEA, when it should be going towards the packet gateway.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- 400 (Page 15, line 1)
- 500 (Page 16, line 18)
- 1100 (Page 24, line 18)

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- 634 (Fig. 6)
- 636 (Fig. 6)
- 722 (Fig. 8)

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4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:
- "client 14" should be "client 24" on page 6, line 29 of the specification.
 - "require" should be "required" on page 19, line 31 of the specification.
- Appropriate correction is required.

Claim Objections

6. Claims 1, 4, 7, and 14 are objected to under 37 CFR 1.75 (a) because of the following informalities:

- Claim 1 recites the limitation "the server client" in line 10. There is insufficient antecedent basis for this limitation in the claim. For purposes of prior art rejection in this office action, the "server client" will be construed as "services client".
- Claim 4 - "claim1" should be "claim 1" in line 1.
- Claim 7: "service client" and "services client" are used interchangeably.
"service agent" and "services agent" are used interchangeably.
Please choose 1 standard and use it throughout the claim.
- Claim 14 recites the limitation "the server client" in line 14. There is insufficient antecedent basis for this limitation in the claim. For purposes of prior art rejection in this office action, the "server client" will be construed as "services client".

Claim Rejections - 35 USC § 102

7. Claims 1, 2, 4, 7, 8, 11, 14, 15, and 17 are rejected under 35 U.S.C. 102(b) as being unpatentable over Esbensen (U.S. 5,796,942).

Regarding Claim 1,

A method for providing surveillance within a communication network, the communication network providing communication services for a subscriber, wherein the subscriber accesses the communication network via an access network (Fig. 3), the method comprising steps of:

Storing surveillance information in a data structure (Column 4, lines 51-52);

Receiving a request for surveillance services from a requesting agency (Column 4, lines 13-16);

Providing a services client element associated with a surveillance target, the services client being interfaced to a surveillance server for generating a duplicate of call information associated with the surveillance target (Fig. 1 and Column 3, lines 49-57);

Selecting a call information interface associated with the surveillance target and the requesting agency (Column 5, lines 56-59);
and

Selecting a call information format associated with the surveillance target and the requesting agency (Column 4, lines 51-59),

Wherein the duplicate of call information is based on the request, and wherein the surveillance server transmits the duplicate of call information to the requesting agency via the call information interface and the call information format (Column 3, lines 49-57 and Column 4, lines 13-16).

Regarding Claim 7,

Claim 7 is a system claim that is substantially equivalent to method claim 1. Therefore, claim 7 is rejected under a similar rationale.

Regarding Claim 14,

Claim 14 is a computer program product including computer-readable medium claim that is substantially equivalent to method claim 1. Therefore, claim 14 is rejected under a similar rationale.

Regarding Claim 2,

The method of claim 1, wherein the surveillance information comprises one of a surveillance feature, a surveillance target identifier, and a requesting agency identifier (Column 4, lines 51-59).

Regarding Claim 8,

Claim 8 is a system claim that is substantially equivalent to method claim 2. Therefore, system claim 8 is rejected under similar rationale.

Regarding Claim 15,

Claim 15 is a computer program product including computer-readable medium claim that is substantially equivalent to method claim 2. Therefore, claim 15 is rejected under a similar rationale.

Regarding Claim 4,

The method of claim 1, wherein the call information interface comprises one of a circuit switched interface and a single packet data interface (Column 7, lines 44-51).

Regarding Claim 11,

Claim 11 is a system claim that is substantially equivalent to method claim 4. Therefore, claim 11 is rejected under a similar rationale.

Regarding Claim 17,

Claim 17 is a computer program product including computer-readable medium claim that is substantially equivalent to method claim 4. Therefore, claim 17 is rejected under a similar rationale.

Regarding Claim 9,

The communication network of claim 7, wherein the services agent element is part of a core network (Fig. 1 and Column 4, lines 13-18).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esbensen (U.S. 5,796,942) in view of Albers et al. (U.S. 6,097,798).

Regarding Claim 5,

Esbensen does not disclose the fact that the call information format comprises one of Telecommunications Industry Association (TIA) format and an European Telecommunications Standards Institute (ETSI) format.

Albers et al., however, disclose this call information format (Column 2, lines 44-63). This new system would be the system of Esbensen including the TIA call information format as shown in Albers et al.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use a TIA or ETSI call information format since Esbensen discusses the fact that the client under surveillance can be on a telephone. It would have been obvious to one of ordinary skill in the art to use a TIA or ETSI call information format since they are the standards for such formats, so as to allow for proper surveillance under the Communications Assistance for Law Enforcement Act (CALEA) (Column 2, lines 44-63).

Regarding Claim 12,

Claim 12 is a system claim that is substantially equivalent to method claim 5. Therefore, claim 12 is rejected under a similar rationale.

Regarding Claim 18,

Claim 18 is a computer program product including computer-readable medium claim that is substantially equivalent to method claim 5. Therefore, claim 18 is rejected under a similar rationale.

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10. Claims 6, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esbensen (U.S. 5,796,942) in view of Stein (U.S. 6,016,432).

Regarding Claim 6,

Esbensen does not disclose the fact that the access network is a radio access network.

Stein, however, discloses this fact in discussing the use of a wireless network (Column 2, lines 4-17). This new system would be the system of Esbensen wherein the access network was wireless, as in Stein's invention.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use the wireless network from Stein in place of the wired network of Esbensen's invention to provide more versatility in network configurations. A person of ordinary skill in the art would have been motivated to use a wireless network in Esbensen's invention so as to allow communication with radio base stations operating in different geographic areas as well as parts of different networks (Column 2, lines 4-17).

Regarding Claim 13,

Claim 13 is a system claim that is substantially equivalent to method claim 6. Therefore, claim 13 is rejected under similar rationale.

Regarding Claim 19,

Claim 19 is a computer program product including computer-readable medium claim that is substantially equivalent to method claim 6. Therefore, claim 19 is rejected under a similar rationale.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esbensen (U.S. 5,796,942) in view of Beranek et al. (U.S. 4,700,340).

Regarding Claim 3,

Esbensen does not disclose the fact that the call information comprises one of bearer information and call signaling information.

Beranek, however, discloses the fact that call information comprises call signaling information (Column 1, lines 12-18). This new system would be the system of Esbensen capturing call signaling information, as in Beranek et al., for surveillance.


It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that Esbensen's invention requires origination signaling and dialed digits to form each record. A person of ordinary skill in the art would have been motivated to retrieve call signaling information so as to add this source and destination information to the record in Esbensen's invention correctly (Esbensen, Column 4, lines 51-59).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Andrew Caldwell